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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,277	02/13/2002	Ian M. Penn	13202.00369	8817

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EXAMINER

BUI, VY Q

ART UNIT	PAPER NUMBER
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3731

14

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/073,277

Applicant(s)

PENN ET AL.

Examiner

Vy Q. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-65 is/are pending in the application.
- 4a) Of the above claim(s) 25-30, 33, 34, 40, 43, 46-50, 54, 55, 64 and 65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24, 31-32, 35-39, 41-42, 44-45, 51-53 and 56-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8, 2.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 13.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of "Restriction Requirement" in Paper No. 12 is acknowledged. The traversal is on the ground(s) that a search of the art for one species will necessarily include a search of the art for other species and the burden on the Examiner to examine all claims in a single application is less than the burden on the Applicant/public to prosecute/search more than one application/patent.

This is not found persuasive because each species in the present application has its own features, some species have different priority dates (for example, species 4 shown in Fig. 4 was disclosed in earlier Canadian Patent 2,175,722 filed May 3, 1986, but not the species shown in Fig. 9) and the Examiner can not determine what features among these features would be claimed by the Applicant for examination. A selection of a species is always helpful to both the Applicant and the Examiner to accelerate the prosecution, especially for a device in a very crowded field, such as a stent, because the elected species provide some focus features of the claimed invention for both the Applicant and the Examiner during the prosecution. In addition, if a generic claim is found allowable, other dependent claims directed to other species will be rejoined and allowed as well.

As confirmed by the Applicant, claims 25-30, 33-34, 40, 43, 46-50, 54-55 and 64-65 are not directed to the elected species and therefore are withdrawn from further consideration. The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 51 recites the limitation "the plurality of radially-expandable circumferential struts" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 24, 35-37, 39, 45, 56-58 and 63 are rejected under 35 U.S.C. 102(e) as being anticipated by ISRAEL et al. (5,733,303).

As to claims 24, 35-36, 39, 45, 56-57 and 63, ISRAEL (Fig. 8; claims 17 and 21) discloses a stent including a series of undulating circumferential portions having struts such as struts 51/54, a plurality of longitudinal portions having longitudinal struts such as strut 67/71 having arcuate, non-sinusoidal flexure means being thinner than struts 51/54 and other limitations as recited in the claims.

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As to claims 37, 58, ISRAEL (Fig. 8) discloses longitudinal portions having struts 67/71 aligned in an interconnected relationship parallel the longitudinal axis of the stent because struts 67/71 of two adjacent longitudinal portions are interconnected by struts such as struts 51/54.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 31-32, 38, 41-42, 51-53 and 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over ISRAEL et al. ((5,733,303).

As to claims 31 and 52, ISRAEL discloses substantially all limitations as recited in the claims, except for a medicinal coating on the stent. It is well known to have a medicinal coating to a stent to promote a treatment of a blood vessel at the location of the stent. It would have been obvious to one of ordinary skill in the art to provide a medicinal coating to ISRAEL stent so as to enhance treatment effect of ISRAEL stent.

As to claims 32 and 53, ISRAEL discloses substantially all limitations as recited in the claims, except for a balloon catheter for deploying the stent as claimed. Balloon catheter is well known for deploying a stent of a material such as a stainless steel. It would have been obvious to one of ordinary skill in the art to provide a balloon catheter

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as recited in the claims so as one can deploy an ISRAEL stent of a material such as a stainless steel.

As to claims 38, 41-42, 59-62, ISRAEL discloses substantially all limitations as recited in the claims, except for a material of the stent such as a stainless steel or a shape memory alloy (Nitinol) as recited in the claims. However, a stainless steel or and a shape memory alloy (Nitinol) are well known for being biocompatible and a suitable material for making a stent. It would have been obvious to one of ordinary skill in the art to make ISRAEL stent of a stainless steel or a Nitinol as claimed, as the materials are well known for making a stent.

As to claim 51, ISRAEL discloses substantially all limitations as recited in the claims, except for a range of thickness of the circumferential struts of about 0.0015 to about 0.0045inches. It would have been obvious to one of ordinary skill in the art to make ISRAEL having a variable thickness in the range as claimed so as to make ISRAEL stent to have a variable flexibility along the longitudinal axis of the stent.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 703-306-3420. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on 703-308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
04/29/2004

Vy Q. Bui  
Primary Examiner  
Art Unit 3731